

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 39

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte FRANK PELOSI JR.

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Appeal No. 1999-1813  
Application No. 08/801,010

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HEARD: November 6, 2001

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Before ABRAMS, McQUADE, and BAHR, Administrative Patent Judges.  
ABRAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1, 4-6 and 8-11, which are all of the claims pending in this application. Claims 2, 3 and 7 have been canceled.<sup>1</sup>

We REVERSE.

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<sup>1</sup>The examiner's statements of the rejections erroneously include claim 7.

### BACKGROUND

The appellant's invention relates to a transition support for supporting flooring over areas of flooring having different heights. An understanding of the invention can be derived from a reading of exemplary claim 1, which appears in the appendix to the appellant's Brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Bell	2,142,832	Jan. 3, 1939
Donovan	4,557,475	Dec. 10, 1985

Claims 1, 4-6 and 8-11 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the appellant regards as the invention.

Claims 1, 4 and 8-11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Bell.

Claims 5 and 6 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Bell in view of Donovan.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the Answer (Paper No. 13) for the examiner's complete reasoning in support of the rejections, and to the Brief (Paper No. 11) and Reply Brief (Paper No. 14) for the appellant's arguments thereagainst.

### OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

#### The Rejection Under The Second Paragraph Of Section 112

It is the examiner's opinion that the claims are indefinite because the appellant defines the invention in claim 1 in part by reference to the uneven floors that it connects, which admittedly are not part of the claimed invention. The appellant has responded to this rejection by citing and discussing the applicable case law which, in sum, stands for the proposition that it is permissible to define an invention in terms of an item with which it is used (Brief, pages 5 and 6). For the reasons set forth by the appellant in the brief, we agree that this rejection is not proper.

The rejection under Section 112 is not sustained.

#### The Rejections Under Section 103

The test for obviousness is what the combined teachings of the prior art would have suggested to one of ordinary skill in the art. See, for example, In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In establishing a prima facie case of obviousness, it is incumbent upon the examiner to provide a reason why one of ordinary

skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. See Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985). To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the appellant's disclosure. See, for example, Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1439 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988).

The appellant's invention is directed to a transition support for supporting flooring extending over adjacent floors of different heights. The invention comprises an elongate wedge having a relatively thick end with an upper portion, a lower portion, and a thickness between the upper and lower portion, the thickness being generally equal to the difference in heights between the two floor areas, a relatively thin end opposite the thick end and parallel to the thick end, and a tapering section interconnecting the upper portion of the thick end and the thin end. Bell discloses a floor mat having a nosing strip at one edge that tapers from the upper surface of the mat to the floor upon which the mat is placed. The function of the nosing strip is not explained, nor are examples of its dimensions provided, although it would appear from the drawings that the distance between the thick end and the thin end is about three times the height of the thick end. It is the examiner's view that all of the subject matter recited in claim 1 is disclosed by Bell, except for the limitation "the

distance between said thick end and said thin end being at least 30 times the thickness of said thick end.” However, it is the examiner’s position, as stated on page 5 of the Answer, that

[i]t would have been an obvious design consideration for one of ordinary skill in the art to form the transition support member of Bell with the aforementioned [the claimed] dimensions, based upon the type of floor/flooring to be used with the support and the amount of height differential and desired transition between the floor heights as discussed above. Note that the functionality of the Bell device is not destroyed by these modifications (since the overall system would still function as intended), but rather the system would be enhanced so that the risk of tripping over the floor height differential is reduced.

We do not agree with the reasoning or the conclusion.

It is axiomatic that the mere fact that the prior art structure could be modified does not make such a modification obvious unless the prior art suggests the desirability of doing so. See, In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). We fail to perceive any teaching, suggestion or incentive which would have led one of ordinary skill in the art to modify the Bell mat in the manner proposed by the examiner. Bell discloses not a transition support for supporting flooring, but a floor mat. While we would admit that the nosing strip disclosed by Bell inherently provides a transition between areas of different heights, the reference does not explicitly recognize the problem of providing a transition which is, to use the language of claim 1, “generally unnoticeable to persons walking across said tapering section and for generally preventing the jostling of wheeled

vehicles crossing said tapering section.” This is one of the stated objectives of the appellant’s invention (specification, page 4), and the appellant’s disclosure includes a representation that this objective is accomplished by tapering the inventive transition support in the manner recited in claim 1 (see original claim 3 and page 7 of the specification, as amended). Thus, from our perspective, the specific limitation regarding the taper of the appellant’s device is not merely a matter of design choice, as the examiner has stated, but constitutes a solution to a problem existing in the art. In the absence of evidence to the contrary, it is our view that the only suggestion to modify the Bell nosing strip in the manner proposed by the examiner is found in the luxury of the hindsight afforded one who first viewed the appellant’s disclosure. This, of course, is not a proper basis for a rejection under Section 103. In re Fritch, 972 F.2d 1260, 1264, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992).

We therefore conclude that the teachings of Bell fail to establish a prima facie case of obviousness with regard to the subject matter recited in claim 1, and we will not sustain the Section 103 rejection of claim 1 or, it follows, of claims 4 and 8-11, which depend therefrom.

Claims 5 and 6 stand rejected on the basis of Bell and Donovan, the latter being cited for teaching the use of vinyl, which is one of the materials recited in claims 5 and 6 from which the support of claim 1 is made. Be that as it may, Donovan does not cure the

defect in the rejection of claim 1 discussed above, and therefore we also will not sustain the Section 103 rejection of claims 5 and 6.

SUMMARY

Neither rejection is sustained.

The decision of the examiner is reversed.

NEAL E. ABRAMS  
Administrative Patent Judge

JOHN P. McQUADE  
Administrative Patent Judge

JENNIFER D. BAHR  
Administrative Patent Judge

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